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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/718,071      | 11/21/2000  | Jay C. Hsu           | KCX-359 (15169)     | 1979             |

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07/01/2003

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/01/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/718,071

Applicant(s)

HSU ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,7-17,19-22,24-27,29 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-17,19-22,24-27,29 and 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u> . | 6) <input type="checkbox"/> Other:  |

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### **DETAILED ACTION**

Claims 1-4, 7-17, 19-22, 24-27, 29 and 44-46 are pending. The Amendment filed 5/8/03, Paper No. 14, amended claims 1 and 22.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed 5/8/03 (Paper No. 14) to the rejection of claims 1-4, 7-17, 19-22, 24-27, 29, 44-46 made by the Examiner under 35 USC 103 and the judicially created doctrine of double patenting, have been fully considered and deemed not persuasive.

The Applicant's amendment filed 5/8/03 (Paper No. 14) is sufficient to overcome the 35 USC 112 rejection over claim 1, in the previous Office Action.

#### ***Double Patenting Rejection Maintained***

The provisional rejection of claims 1-4, 11, 13, 14-17, 19-22, 26-27 and 29 under the judicially created doctrine of double patenting as being unpatentable over claims 1-3, 6, 8, 10-12, 14-17, 27-31, 34, 366, 38-40, 42 and 43-44 of copending Application No. 09/717,939<sup>3</sup> is MAINTAINED for the reasons set forth in the Office Action mailed 3/25/03, Paper No. 13, and those found below.

Applicant states, "Applicants agree to submit a terminal disclaimer at such time that the claims of the present application are deemed to otherwise be allowable". This statement is acknowledged.

#### ***112 Rejection Maintained***

The rejection of claim 46 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 3/25/03, Paper No. 16, and those found below.

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(i) The rejection of claim 46 is maintained. Applicant has provided no arguments over this rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 7, 8, 11-17, 19-21 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimberly-Clark (WO 00/64408).

Kimberly-Clark teaches wet wipes comprising oil-in-water emulsions comprising 0.1-30% natural fat or oil, 0.1-10% sterol, 0.1-99.5% humectant, 0.5-20% emulsifying surfactant and water. The aqueous phase of the emulsion comprises alcohol and water. Water comprises 45-99.5% of the emulsion. Antimicrobials, antifungals, emollients, preservatives, and natural moisturizing agents are disclosed as additives. The basis weight of the wet wipes is 25-120g/m<sup>2</sup>. Exemplified is an emulsion comprising 90% water, 5% glycerin, 3% glyceryl stearate SE (surfactant), borage oil, aloe, and tocopherol acetate. Sorbitol is taught as an additional humectant. Talloweth-60 myristyl glycol is taught as a preferred emulsifying surfactant. The reference lacks a teaching of the add-on level of the composition to the wipe. See pg. 4, lines 20-29; pg. 5, lines 5-21; pg. 11, line 18-pg. 12, line 24; pg. 18, line 17-pg. 19, line 24; pg. 22, line 33-pg. 23, line 9.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kimberly-Clark to exemplify the emulsion as having an add-on level of 1-10% of the wipes because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 1-4, 7-12, 14-17, 19-22, 24-27, 29 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammonds et al. (WO 98/03147) in view of Kimberly-Clark (WO 00/64408).

Hammonds et al. teach wet wipes of fibrous sheet materials that are partially saturated with an aqueous solution comprising 0.5-50% oat extract and 10-90% solubilizing agent. The aqueous liquid comprises 0.5-10% of the composition. The wipes have a basis weight of 5-200 grams/m<sup>2</sup>. The oat extract comprises skin protectants and emollients. Propylene glycol and sorbitol are disclosed as solubilizing agents. Emollients, moisturizers, additional surfactants, and preservatives are disclosed as additional ingredients. The solution may be added to the fibrous sheet material at an add-on level of about 0.1-50%. Towels are taught as another form of the product. The reference lacks an exemplification of the instant product and alkoxyated surfactants. See pg. 2, lines 4-12 and 34; pg. 3, line 5-pg. 4, line 2; pg. 4, line 30-pg. 5, line 29; pg. 6, lines 1-8; pg. 5, lines 24-31; pg. 7, lines 16-35; pg. 14-16.

Kimberly-Clark teach a wet wipe comprising an oil-in-water emulsion. Talloweth-60 myristyl glycol (alkoxyated surfactant) is taught as a preferred emulsifying surfactant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the talloweth-60 myristyl glycol taught by Kimberly-Clark to the composition

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of Hammonds because a) Kimberly-Clark teach talloweth-60 myristyl glycol as an emulsifying surfactant useful in cosmetic compositions; b) Hammonds teaches that surfactants can be added to her compositions as solubilizing agents to avoid using the skin irritants butylene and propylene glycol; thus, one of skill in the art would be motivated to add talloweth-60 myristyl glycol to the composition of Hammonds in place of butylene glycol or propylene glycol because of the expectation of achieving a product that does not irritate the skin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant paper product using the teachings of Hammonds et al. because a) Hammonds teaches a wet wipe or towel comprised of a paper web and a water-soluble composition, wherein the add on level of the composition is 1-10% of the paper product, wherein water comprises 10% of the composition, glycerin comprises 10-90% of the composition, and the surfactant comprises 0.25-5% of the composition; b) Hammonds teaches glycerin as a solubilizing agent that effectively solubilizes the oat extract without irritating the skin; thus, one of skill in the art would be motivated to exemplify the paper product of Hammonds with glycerin as the solubilizing agent because of the expectation of achieving a product that does not irritate the skin.

### ***Response to Arguments***

Applicant argues, "However, WO 00/64408 is not effective as prior art under 35 USC 102(b). In addition, WO 00/64408 has an international filing date prior to the November 29, 2000, and thus, is examined under 35 USC 102(e) prior to the American Inventors Protection Act of 1999. . . Thus, it is believed the WO 00/64408 is not available as prior art to the present

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application". This argument is not persuasive, as WO 00/64408 is still available as prior art under 35 USC 102(a).

Applicant argues, "WO 98/03147 does not disclose the use of an alkoxylated alcohol surfactant. In fact, the specific surfactants mentioned are said to be used for improving skin cleansing properties". This argument is not persuasive. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner respectfully points out that this rejection was made in combination with WO 00/64408, which teaches alkoxylated alcohol surfactants.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

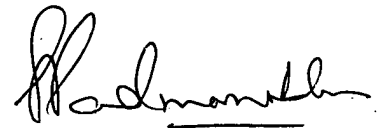
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
June 30, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

6/30/03